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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,579	05/04/2005	Philippe Bertrand	BC-01US	4029
50446 7590 12/29/2009 HOXIE & ASSOCIATES LLC 75 MAIN STREET, SUITE 301 MILLBURN, NJ 07041				
EXAMINER				
CHAWLA, JYOTI				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
12/29/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/521,579

Applicant(s)

BERTRAND ET AL.

Examiner

JYOTI CHAWLA

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 8, 10 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 8, 10 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission and amendments filed on November 9, 2009 have been entered. Claim 1 has been amended and claims 1, 4, 8, 10 and 13 are examined in the application.

Claim Objections

Minor informalities:

Applicants' status identifier for claims 4, 8 and 10 is incorrect. Applicants' submission has been accepted to expedite prosecution, however, for future reference the applicant is requested to use the status (previously presented) for claims that have been previously amended but have not been changed in the latest submission. Status identifier of claim 13 is correct.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2) Claims 1, 4, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffett (WO 98/13133) in view of Itagaki et al (EP 0564787 A2), hereinafter Itagaki.

Note: Gelatin substitute as defined by the specification does not have gelling properties like gelatin, however, has stabilization properties like gelatin and can be added to culinary preparations which are heated above 60°C. (Original disclosure, page 2, line 29-page3, line 10).

Regarding claim 1, Duffett teaches of powdered form of cocoa butter (e.g., Page 12, line 31 to page 13, line 20). Cocoa butter as taught by Duffett is a vegetable fat consisting essentially of at least 99 weight % cocoa butter and thus is a non-gelling gelatin substitution product, as claimed.

Duffett is silent as to the cocoa butter being deodorized. Itagaki teaches of confectionery fat composition including deodorized cocoa butter (e.g., Page 3, lines 10-31). Regarding deodorizing cocoa butter to an extent of 90-95%, as recited in claim 1, Itagaki teaches of steam distillation method for deodorizing cocoa butter in the

temperature range of 160 °C to 200 °C, which falls in the range of "approximately 160 °C" as disclosed by the applicant, thus, the deodorized cocoa butter of Itagaki includes 90-95% deodorized cocoa butter, as recited. Thus, deodorized cocoa butter was known and available at the time of the invention. Cocoa butter typically has strong flavor, which is undesirable if the cocoa butter is to be incorporated into food products which are not cocoa butter flavored, e.g., in vanilla or fruit flavored products (For example, see Itagaki, Page 3, lines 9-12).. Deodorized cocoa butter as taught by Itagaki, does not have a strong flavor, and thus can be advantageously incorporated in food products of various flavors. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Duffett and use deodorized cocoa butter to make the powder form. One of ordinary skill would have been motivated to modify Duffett at least for the purpose of removing the undesirable cocoa butter flavor and making the fat based powdered product more versatile and usable in foods with other flavors, such as vanilla and fruit flavors etc., as taught by Itagaki (Page 3, lines 9-12).

Regarding claim 4, Duffett teaches that a fat composition may also comprise color, flavor and or vitamins, typically, oil soluble vitamins (Page 8, lines 14-21). It is noted that oil soluble vitamins include vitamins A and E, which are antioxidants. Thus, Duffett teaches of powdered fat based products comprising antioxidants as recited.

Claim 10, recites of a method of incorporating a cocoa butter containing composition into a culinary preparation, wherein the culinary preparation has a moisture content of 40 to 50%. Duffett teaches of chocolate, cereals, ice cream, chocolate drinks, chilled products etc., made by incorporating the cocoa butter powder (e.g., see Page 13, lines 1-20), i.e., culinary preparations containing the recited product. Regarding the moisture content, it is noted that the moisture content of a given food can be obtained by subtracting the total solids weight from the total food weight. Since Duffett teaches of incorporation of cocoa butter containing product in culinary preparations ranging from very low moisture content cereals to high moisture content ice creams and drinks etc., therefore it would have been obvious to one of ordinary skill in the art at the time of the

invention to use Duffett's cocoa butter product in culinary preparations with moisture content of 40-50%.

3) Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffett and Itagaki, further in view of Kawabata et al (US 5460847), hereinafter Kawabata.

Duffett in view of Itagaki have been relied on for the rejection of claim 1 above.

Claim 8, recites a method of incorporating the product comprising at least 99% of cocoa butter powder in a culinary preparation by directly adding into the preparation when the latter is heated to a temperature of greater than 60°C. Claim 13 recites of subsequently cooling the resulting culinary preparation.

Duffett teaches of chocolate, cereals, ice cream, chocolate drinks, chilled products etc., made by incorporating the cocoa butter powder (e.g., see Page 13, lines 1-20), i.e., product is incorporated directly into the preparation. Regarding the temperature limitation of "heating the food product to greater than 60°C", Duffett is silent. However, heating a culinary preparation to a temperature greater than 60°C and adding components while the product is being cooked or heated was well known in the art at the time of the invention. For example, in the making of chocolate (a culinary preparation also disclosed by Duffett), it was known to heat the components to a temperature of 65-70°C (Kawabata, Column 3, lines 9-11) and then adding fats and oils including cocoa butter (Kawabata, Column 2, lines 32-37), as recited in claim 8.

Kawabata also teaches of cooling the resulting emulsion to less than 40°C (Column 3, lines 18-20), which includes applicants' recited temperature range for claim 13.

Kawabata teaches an emulsion that has good workability and does not experience oil separation (e.g., Column 1, lines 42-50). Thus, incorporating a product comprising 99% or more cocoa butter in powder form in foods, such as, chocolate, was known in the art (Duffett). Further, heating to a temperature of 60°C or higher and adding fat based products, such as, cocoa butter, and then cooling the resulting product to make chocolate product was also well known in the art at the time of the invention, as taught

by Kawabata (Column 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Duffett in view of Kawabata and heat the chocolate making components to a temperature range above 60°C as taught by Kawabata, before adding the cocoa butter product and subsequently cooling the emulsion to less than 40°C. One of ordinary skill would have been motivated to modify Duffett at least for the purpose of obtaining an emulsion which has good workability and does not suffer from oil separation upon heating and subsequent cooling to a desired use temperature.

Furthermore, regarding claim 13, as recited, it is noted that any culinary preparation (to which heat is not applied), when left at room temperature over a period of time will cool to "room temperature". Thus, the property of the product recited in claim 13, is also possessed by the chocolate product of Duffett.

Response to Arguments

Applicant's arguments of 11/9/2009 with respect to claims have been considered but have not been found persuasive.

I) Applicants' argue that Duffett does not teach the claimed invention (See remarks, page 3, paragraphs 3-4). Applicant seem to arrive at this conclusion based on Duffett's addition of powdered cocoa butter mass in making of chocolate. This argument is not persuasive. First of all applicants' have presented argument against one reference where the rejection was based on a combination of references. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicants' also argue that Itagaki teaches away from the claimed invention (Remarks, page 4, , lines 3-5). This argument is also not persuasive because: Duffett teaches of

powdered form of cocoa butter (e.g., Page 12, line 31 to page 13, line 20). Cocoa butter as taught by Duffett is a vegetable fat with at least 99 weight % cocoa butter and thus is a non-gelling gelatin substitution product, as claimed. Duffett is silent as to the cocoa butter being deodorized. Itagaki teaches of confectionery fat composition including deodorized cocoa butter (e.g., Page 3, lines 10-31). Regarding deodorizing cocoa butter to an extent of 90-95%, as recited in claim 1, Itagaki teaches of steam distillation method for deodorizing cocoa butter in the temperature range of 160 °C to 200 °C, which falls in the range of "approximately 160 °C" as disclosed by the applicant, thus, the deodorized cocoa butter of Itagaki includes 90-95% deodorized cocoa butter, as recited. Thus, deodorized cocoa butter was known and available at the time of the invention. Cocoa butter typically has strong flavor, which is undesirable if the cocoa butter is to be incorporated into food products which are not cocoa butter flavored, e.g., in vanilla or fruit flavored products (For example, see Itagaki, Page 3, lines 9-12).. Deodorized cocoa butter as taught by Itagaki, does not have a strong flavor, and thus can be advantageously incorporated in food products of various flavors. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Duffett and use deodorized cocoa butter to make the powder form. One of ordinary skill would have been motivated to modify Duffett at least for the purpose of removing the undesirable cocoa butter flavor and making the fat based powdered product more versatile and usable in foods with other flavors, such as vanilla and fruit flavors etc., as taught by Itagaki (Page 3, lines 9-12).

In response to applicant's argument that Itagaki can not be combined with Duffett (see Remarks, page 4, last paragraph), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Itagaki is relied upon to provide evidence that

deodorized cocoa butter was known and available at the time of the invention, as discussed in the rejection above.

Regarding the argument (Page 3) of Duffett utilizing cocoa butter product to make chocolate and not to stabilize a composition as recited. Applicants' further argue that one of skill in the art would not seek to eliminate cocoa butter flavor, i.e., chocolate flavor, when manufacturing chocolate. In response to applicant's arguments, it is noted that a recitation of the intended use of the claimed invention (powdered cocoa powder that is deodorized) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case Duffett in view Itagaki teaches a cocoa butter powdered product that is deodorized, as is instantly claimed and the stabilization or gelation properties are a function of the product, which is taught by the combination of references and thus Duffett in view of Itagaki meet the instantly claimed limitations.

II) Applicants' also argue that Itagaki discloses tempered cocoa butter, but fat compositions that are tempered can hardly be whipped (page 4, lines 8-9 and page 5, lines 7-8). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "tempered product can hardly be whipped") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, claims 1, 4, 8, 10 and 13 remain rejected for reasons of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI CHAWLA whose telephone number is (571)272-8212. The examiner can normally be reached on 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JC/
Examiner
Art Unit 1794

/Keith D. Hendricks/
Supervisory Patent Examiner, Art Unit 1794